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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/898,853	07/25/1997	HISASHI YAMAGISHI	Q45980	6473

7590 05/23/2003
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EXAMINER
GORDON, RAEANN

ART UNIT	PAPER NUMBER
3711	51

DATE MAILED: 05/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Response to Reply Brief

The reply brief filed 3-20-03 has been entered and considered. In section II appellant states the Examiner now offers a new argument concerning the definition of the word "cover". Appellant further states the position is new and was never articulated by the Examiner during the prosecution. It is not clear how appellant argues the definition of the word "cover" was never presented when the crux of the appeal is based on this fact. The office action (paper number 25) mailed on February 13, 2001 clearly points out and defines what appellant defines as a cover layer. Paper number 25 recites "As applicant's original disclosure states that the cover consists of at least two layers, applicant's claimed cover must be read to include the at least two cover layers.". In section II Appellant further argues there is no requirement that the cover consists of two separate and distinct layers. While this argument is true for golf balls in general it is not true for the golf ball of the present invention. Appellant chose to define the "cover" as a cover consisting of at least two layers, therefore the definition as defined by the specification must not be ignored. The "cover" cannot refer in general to the "outer cover layer" as explained by Appellant (page 3, para 3). The term "cover" has to be considered in the manner in which it is defined in the specification. Appellant clearly defines the "cover" consists of an inner cover layer and an outer cover layer. This definition is not and cannot be considered an "unstated limitation" as argued by appellant (page 4, para 1) when a definition is clearly set forth in the specification.

In section III, appellant argues the reliance on *Gentry Gallery Inc v. Berkline Corp* 45 USPQ2d 1498 is inapposite. The Examiner disagrees. The case involves

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prosecution history estoppel as does the present application. The case is cited to prove that applicants are not allowed to argue a specific point to overcome a reference and change the argument at a later date to overcome a different rejection. As shown in the Examiner's Answer, appellant argues in paper number 6 that prior art showing a three piece core and a cover is completely distinguishable from the ball of the present invention, which claimed a core and cover consisting of inner and outer layers (paper #6, pg 5, lines 3-7 and 18-19). Under file wrapper estoppel as shown in the Gentry v. Berkline case appellants are estopped from arguing points that are inconsistent with previous arguments.

In section IV, appellant states the Examiner never addresses and hence does not dispute the decision by the BPIA where it addressed the very issue in favor of appellant. Appellant then argues the Examiner fails to follow the precedent set by the prior decision. Appellant is correct in stating the Examiner does not dispute the decision set forth by the BPIA in another application. However, the issue in question is not relevant to the decision rendered in that particular application. As the Examiner has reiterated in the previous office actions, including the Examiner's Answer, the dilemma in the instant application is prosecution history estoppel. Of course the previous decision by the BPIA is consistent with Appellant's position but Appellant's position is not consistent with position taken during the earlier part of the prosecution of this application. As previously stated, Appellant is not allowed to take a position to overcome prior art and then take the opposite position during a later part of the prosecution. Appellant last contention is that the Examiner never attempts to explain the prior positions taken by the PTO, the

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declaration (Ex B), or the evidence listing various other patents describing an intermediate layer as a core or a cover (Ex C). Once again, Appellant argues issues that are irrelevant to the instant application. The determination as to whether or not a core layer, an intermediate layer, or cover layer is interchangeable in meaning is not an issue in this application. The issues before the BPJA are 1) Appellant's definition of the word "cover" as defined in the specification and 2) prosecution history estoppel. In regards to issue 1, Appellant defines the cover in the specification as a cover consisting of at least two layers which Appellant argues does not necessarily mean two layers. In regards to issue 2, Appellant previously argued a golf ball comprising a three piece core and cover was completely distinguishable from a golf ball comprising a core (two layers) and a cover consisting of an inner cover layer and a outer cover layer; while Appellant is now arguing there is no difference between layers in golf balls.

In conclusion it is submitted that Appellant cannot within the original disclosure disclose that the invention must have a two-layer cover then subsequently argue the claimed cover does not literally mean a cover consisting of two layers. It is also submitted that Appellant cannot argue a golf ball comprising a three piece core and cover is completely distinguishable from a golf ball comprising a core (two layers) and a cover consisting of an inner cover layer and a outer cover layer and then subsequently argue there is no difference between layers in golf balls.

The application has been forwarded to the Board of Patent Appeals and Interferences for decision on the appeal.

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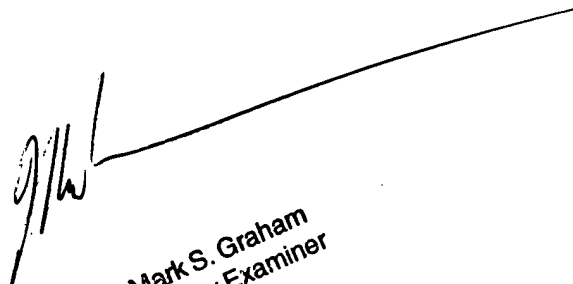
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raeann Gorden whose telephone number is 703-308-8354. The examiner can normally be reached on M-F 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Sewell can be reached on 703-308-2126. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

rg
May 22, 2003



Mark S. Graham
Primary Examiner